

Serial No. 09/851,245
Reply To Office Action Of April 8, 2003

Remarks/Arguments:

By the above amendments, Applicant has amended claims 1 and 7, canceled claims 6 and 8 - 27, and added new claims 28-35. Consequently, claims 1-5, 7, and 28-35 are now presented for consideration.

Rejections Under 35 USC § 112 First Paragraph

In the Office Action, claims 6, 8, 9, 25 and 27 were rejected under 35 USC § 112. Claims 6, 8, 9, 25 and 27 have been canceled.

Obviousness-Type Double Patenting Rejections

In the Office Action, various groups of claims 1-5, 10-17, 22, 23, 24, 26, were rejected under the judicially created doctrine of obviousness-type double patenting, over combinations of Applicant's commonly assigned patent nos. 6,451,189, 6,507,664 and 6,398,932 and Minden et al., US patent no. 6,043,025. Applicant has submitted herewith a Terminal Disclaimer that limits the enforceable term of the instant application to the enforceable life of patent nos. 6,451,189, 6,507,664 and 6,398,932 so long as they all remain commonly assigned. Applicant respectfully requests that these rejections be withdrawn.

First Rejections Under 37 CFR § 103

In the Office Action, claims 1-5, 10-16, 20, 22-24 and 26 were rejected under 37 CFR § 103, over the machine translation of Ando (JP 07260742) in view of Minden et al. (US 6,043,025).

Applicant respectfully requests reconsideration of the rejection because neither the Ando reference or the Minden et al. reference, considered alone or in combination with one another discloses or suggests the combination of features of the present invention recited in independent claim 1. Specifically, neither reference either suggests or discloses generating

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machine-readable instructions that direct a robotic device to remove at least one of said selected bio-molecules from said two-dimensional array. The Ando reference discloses scanning of an array to extract an electrophoresis pattern, but fails to disclose removal of spots represented by the extracted pattern. For instance, in paragraph [0012] of Ando, there is a description that includes obtaining "the strength of the image of fluorescence". Paragraphs [0012] through [0014] do not describe removal of spots from the array, as alleged in the Office Action, but rather describe the extraction of a pattern from the array. No cutting tool or cutting instrument is described or shown. Rather, a head 10 equipped with an "ultraviolet line light source" extracts an image or pattern "without imprinting the electrophoresis pattern . . . to a photographic plate". (see [0018]).

For this reason and others, Applicant respectfully asserts that the rejection is improper and should be withdrawn.

However, to more clearly verbalize the various aspects of the invention recited in claim 1, Applicant has made minor amendments to claim 1 to clarify the recitation therein. Further, Applicant has canceled claims 10-16, 20, 22-24 and 26.

Second Rejections Under 37 CFR § 103

In the Office Action, claims 6-9, 18 and 19 were rejected under 37 CFR § 103, over the machine translation of Ando (JP 07260742) in view of Minden et al. (US 6,043,025), further in view of Lugoian (US 5,543,023) and Allen et al. (US 4,746,551).

As with the first rejection under 37 CFR § 103, Applicant again asserts that this rejection is improper because the Ando reference has been mis-applied. Ando fails to suggest or disclose the recited feature of claim 1 that includes removing at least one of bio-molecule from the array using computer readable instructions. Further, the Minden et al., Lugoian and Allen et al. references also fail to teach, disclose or suggest this feature. It would not have been obvious for a person of ordinary skill in the art to combine the cited references to achieve the claimed invention. For this reason and others, Applicant respectfully request that the rejection be rescinded.

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Third Rejection Under 37 CFR § 103

In the Office Action, claim 17 was rejected under 37 CFR § 103, over the machine translation of Ando (JP 07260742) in view of Minden et al. (US 6,043,025), further in view of Hochstrasser (US 5,773,645).

As with the first and second rejections under 37 CFR § 103, Applicant again asserts that this rejection is improper because the Ando reference has been mis-applied. Ando fails to suggest or disclose the recited feature of claim 1 that includes removing at least one of bio-molecule from the array using computer readable instructions. Further, the Minden et al., and Hochstrasser references also fail to teach, disclose or suggest this feature. It would not have been obvious for a person of ordinary skill in the art to combine the cited references to achieve the claimed invention. For this reason and others, Applicant respectfully request that the rejection be rescinded..

Fourth Rejection Under 37 CFR § 103

In the Office Action, claims 20 and 21 were rejected under 37 CFR § 103, over the machine translation of Ando (JP 07260742) in view of Minden et al. (US 6,043,025) Hochstrasser (US 5,773,645), and further in view of Lugojan (US 5,543,023) and Allen et al. (US 4,746,551).

As with the first, second and third rejections under 37 CFR § 103, Applicant asserts that this rejection is improper because the Ando reference has been mis-applied. Ando fails to suggest or disclose the recited feature of claim 1 that includes removing at least one of bio-molecule from the array using computer readable instructions. Further, the Minden et al., Hochstrasser, Lugojan and Allen et al. references also fail to teach, disclose or suggest this feature. It would not have been obvious for a person of ordinary skill in the art to combine the cited references to achieve the claimed invention. For this reason and others, Applicant respectfully request that the rejection be rescinded.

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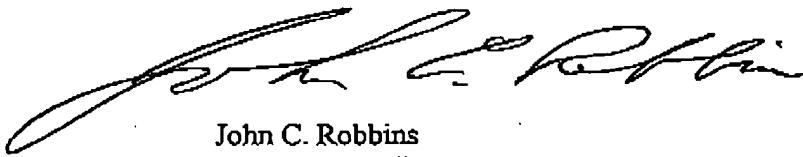
PCT Publication WO 99/63351 to Oxford Glyco-Sciences

As stated in the PRELIMINARY REMARKS filed with the instant application on May 9, 2001, several of the examined claims in the instant application were copied from PCT Publication WO 99/63351 to Oxford Glyco-Sciences (OGS). PCT Publication WO 99/63351 to OGS apparently has a US counterpart that has issued as US Patent No. 6,459,994 (the OGS Patent) and has a foreign priority claim of May 28, 1998. The instant application has a priority date of June 24, 1997 and therefore, the OGS patent is not prior art against the instant application. Regardless, the OGS patent is being submitted herewith in an accompanying IDS for the Examiner's consideration.

Applicant respectfully asserts that the claims are allowable and that the application is now in condition

Thank you. If you have any questions, please feel free to contact the undersigned.

Respectfully submitted,



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